

## REMARKS

The last Office Action has been carefully considered.

It is noted that claim 1 is rejected under 35 U.S.C. 103(a) over the U.S. patent to Reeder in view of the U.S. patent to Met.

Claims 1-5 are rejected under 35 U.S.C. 103(a) over the U.S. patent to Reeder in view of the U.S. patents to Met and Brueck.

Claims 1-8 are rejected under 35 U.S.C. 103(a) over the U.S. patent to Reeder in view of the U.S. patents to Met, Brueck and Tibbals.

Claims 1-7 and 9 are rejected under 35 U.S.C. 103(a) over the U.S. patent to Reeder in view of the U.S. patents to Met, Brueck, Tibbals and Isenberg.

Claims 1-7 and 10-12 are rejected under 35 U.S.C. 103(a) over the U.S. patent to Reeder in view of the U.S. patents to Met, Brueck and Tibbals, and further in view of the U.S. patent application publication to Cresswell.

Claims 1-7 and 13-14 are rejected under 35 U.S.C. 103(a) over the U.S. patents to Reeder, in view of the U.S. patents to Met, Brueck, Tibbals and Kaplan.

Claims 1-16 are rejected under 35 U.S.C. 103(a) over the U.S. patents to Reeder, Met, Brueck, Tibbals, Isenberg, U.S. patent application publication to Cresswall, U.S. patents to Kaplan and Wallace, and British patent document to Ball.

At the same time, the claims are objected to.

It is respectfully submitted that the Examiner's objection to the claims because of the multiple dependency is a result of misplacement of a Simultaneous Amendment which was filed simultaneously with filing of the above identified application and in which the claims were amended to eliminate the multiple dependency. However, in order to be responsive, applicants amended the claims to eliminate the multiple dependency again.

Also, claim 1 has been amended to provide its further clarification as required by the Examiner.

The specification has been amended to make a reference to the priority application, to provide corresponding headings, and to make other desirable changes.

It is believed that the above mentioned amendments to the claims and the specification should be entered.

Also new claims 17-19 have been added, that have support on page 5, lines 4-10 of the specification.

In connection with the Examiner's rejection of the claims over the art, claim 1, the broadest claim on file, together with other claims have been retained substantially as they were. Also, new claims 17-19, which depend directly or indirectly on claim 1 have been added.

Turning now to the Examiner's rejection of the claims over the art, it is respectfully submitted that claims 1-17 have been rejected under 35 U.S.C.

103 as obvious over various combinations of prior art references. In regard to claim 16, the Examiner has combined not less than 9 prior art references in formulating the obviousness rejection. It is believed that it would be advisable to cite the decision in *re Blamer*, Civ. Upp. No. CAN 93-1108, SO. At 3-4 (Fed. Cir September 21 1993), in which it was stated:

The Examiner concluded that applicant's invention would have been obvious in light of 12 references. The Board correctly stated that the Examiner's reliance on so many references was "overkill" and concluded that applicant's invention would have been obvious in light of four of the references. We agree with the Board on the former statement but disagree with the latter. Would both the Examiner and Board have done is to cite a number of references, variously containing some of the limitation in applicant's claims. However, these references and the limitations for which they were cited were combined piecemeal without any suggestion or motivation for their combination and without regard to the purpose of applicant's invention...

It is believed that this decision is clearly applicable to the obviousness rejections applied in this case, in particular to the rejection of claim 16.

Coming now to the Examiner's rejection of claim 1, the broadest claim on file, this claim was rejected under 35 U.S.C. 103(a) over the U.S. patent Reeder in view of the U.S. patent to Met.

The Examiner indicated that in his opinion the patent to Reeder disclosed all features of claim 1 except that the three adjusting pins were offset from one another in the circumferential direction in the mirror holder. The

Examiner however failed to establish *prima facie* obviousness since not every claim limitation is taught or suggested by the above identified prior art, as required by MPEP § 2143.03.

At least two features which are now defined in claim 1 are not disclosed in any of the above identified references, and therefore the Office Action erred substantially as to factual findings based on *Graham v. John Deere, Co.*, 1996.

The first feature which is not defined in claim 1 is that none of the references discloses "three adjusting pins which pass through holes... in the mirror holder" as defined in claim 1. In the patent to Reeder the threaded screws 24 and 32 do not pass through holes in the movable plate 16. The only apparent hole in this "mirror holder" is the mirror receiving aperture 20. Likewise, in both embodiments disclosed in the patent to Met, the ring plate 2 onto which the mirror is mounted receives two pins 4 and 5. The other adjustment pins 7 and 8 do not pass through holes in the mirror holder.

Claim 1 further defines "three adjusting pins...braced by their brace points on buttresses embodied on the holder profile section". In the patent to Reeder, the part that would correspond to the holder profile section, in particular the base plate 12, has no buttresses onto which pins are braced. The threaded

screws 24 and 32 pass through the base plate 12. The same is true for the plate 1 of the patent to Met. Alignment screws 7 and 8 pass through the plate 1, but no alignment screws bear upon it.

It is the immaterial whether the above discussed differences with the cited references are obvious or non obvious to satisfy the Graham factual inquiries. Therefore, in view of the above presented arguments, the rejection of claim 1 should be withdrawn.

It is further respectfully submitted that the Examiner's arguments for combining the patents to Reeder and Met with one another are not justified. As specified in the Office Action:

It would have been obvious to one of ordinary skill in the art ... to modify the device of Reeder to have concentric pattern taught by Met because the mirror holder can be tilted about any resultant axis intersecting its center axis at right angles provided the bolt circle is concentric with said center axis. One would have been motivated to make this modification because the ability to tilt at all axes may make it more likely that the optical device will be properly aligned.

This reasoning however is incorrect since the device disclosed in the patent to Reeder already has the ability to tilt at all axes. This is certainly the case for the embodiment disclosed in column 3, lines 54-57 of the patent to Reeder. With three springs 22, the mirror mount assembly is "capable of movement in three orthogonal directions". However, the three springs 22, even

in this example, are not offset from one another in the circumferential direction of the mirror holder. It is therefore believed to be clear that there is no plausible rationale for combining these references, and this is the second reason for withdrawing the rejection of claim 1 under 35 U.S.C. 103(a) over these references.

None of the other cited references disclose the above mentioned new features of the present invention as defined in claim 1.

Claim 1 therefore should be considered as allowable, together with all dependent claims which depend on it and share its allowable features.

The Examiner's attention is further respectfully directed to the features of claim 4, which was rejected under 35 U.S.C. 103(a) over the patent to Reeder in view of the patents to Met and Brueck. In the Office Action the Examiner stated:

Since Reeder, Met and Brueck teach alignment devices, it would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the device of Reeder, in view of Met, to have the radial slot configuration taught by Brueck which facilitates adjustment of the optical assembly (see Brueck, column 2, lines 21-25).

The patent to Brueck discloses a diaphragm actuating disk 26 which is configured with several radial slots 25. The rotation of the disk 26 about

its central axis causes diaphragm blades 23, each having a projection 24, to reposition so as to open and close the iris diaphragm. Claim 4 currently on file defines that "all the buttresses are embodied as radial longitudinal grooves". These grooves 46 do not rotate and do not act as actuating members. They remain in a fixed position and provide a path for adjusting pins 37 when they are adjusted by moving them in an axis nominally perpendicular to the grooves. There is no functional or operational similarity between the diaphragm ring of Brueck and the present invention. The manner in which Brueck "facilitates adjustment of the optical assembly" is not applicable to the present invention and can not be combined with the disclosures of the patents to Reed and Met to arrive at the applicant's invention.

In view of the above presented remarks and amendments, it is respectfully submitted that all the claims currently on file should be considered as patentably distinguishing over the art and should be allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is

respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', with a long horizontal flourish extending to the right.

Michael J. Striker  
Attorney for Applicants  
Reg. No. 27233